

Trade Mark Practice Guideline Amendment – Major Event Emblems

The Major Events Management Act 2007 (the Act) came into effect on 23 August 2007. The Act introduces a number of obligations for the Commissioner of Trade Marks and section 83 of the Act repeals sections 20A to 20B of the Flags, Emblems and Names Protection Act 1981.

In order to assist its examiners in compliance with the Major Events Management Act 2007, IPONZ amended its Practice Guidelines on Absolute Grounds: General by:

1. Deletion of [clause 3.1.5.9](#); and
2. Insertion of a [new clause 3.1.9](#) as set out below:

3.1.9 Major Events Management Act 2007

The Major Events Management Act 2007 introduces a number of obligations for the Commissioner of Trade Marks, details of which are set out below.

The term “emblem” is defined in section 4 of the Major Events Management Act 2007 as meaning:

...an identifying device, seal, indicium, image, mark, trade mark, badge, symbol, design, logotype, or sign; and includes any printed or other visual representation of the emblem –

- (a) on a flag, banner, sign, or other printed or written material; or
- (b) made by way of a pictorial representation or other visual image; or
- (c) made in any other manner

3.1.9.1 Major event words and emblems

Part 2 of the Major Events Management Act 2007 provides for protection of words and emblems that are likely to be associated with events that have been declared a “major event” by Order in Council.

Section 15(1) of the Major Events Management Act 2007 provides that the Commissioner of Trade Marks must not register an emblem if the use of that emblem by that person would breach section 10.

Section 10 of the Major Events Management Act 2007 provides, subject to certain exceptions, that:

No person may, during a major event’s protection period, make any representation in a way likely to suggest to a reasonable person that there is an association between the major event and -

- goods or services; or
- a brand of goods or services; or
- a person who provides goods or services.

Section 11 of the Major Events Management Act 2007 states that a Court may presume a representation is in breach of section 10 if it includes any of the following (even if words such as “unauthorised” or “unofficial” are used):

- a major event emblem; or
- a major event word or major event words; or
- a representation that so closely resembles a major event emblem, a major event word, or major event words as to be likely to deceive or confuse a reasonable person.

Where the following circumstances apply, the examiner should therefore raise concerns that the mark is not registrable under section 17(1)(b) of the Trade Marks Act 2002, with reference to section 15 of the Major Events Management Act 2007:

The mark consists of or includes an emblem and/or word that has been declared a major event emblem or major event word, or so closely resembles a major event emblem, word, or words as to be likely to deceive or confuse a reasonable person;

The application for registration was filed during the major event's protection period or the application for registration was filed before the start of the protection period but is not registered at the start of the protection period;

Use of the mark is not covered by one of the relevant exceptions in section 12 of the Major Events Management Act 2007 namely:

The applicant for the mark is, or has the written authorisation of, the major event organiser as specified in the Order in Council;

The word or emblem comprises the whole or part of:

- the proper name of any town or road or other place in New Zealand; or
- the legal or trade name of the person making the representation; or
- an existing registered trade mark

The examiner should also consider whether use of the mark would be likely to deceive or cause confusion. For example, if use of the mark may imply sponsorship, permission or approval by the major event organiser an objection may be relevant under section 17(1)(a) of the Act.¹

3.1.9.2.1 Major Events Management (Rugby World Cup 2011) Order 2007

The Rugby World Cup 2011 was declared to be a major event, of which the major event organiser is Rugby World Cup Limited, pursuant to section 7 of the Major Events Management Act 2007 with effect on 28 September 2007.

The Major Event Emblems and Words (Rugby World Cup 2011) Order 2008 came into force on 11 September 2008. That Order provides that the protection period for the Rugby World Cup 2011 is from 11 September 2008 ending on 21 November 2011.

Schedules 1 and 2 of the Order respectively set out the emblems and words which are declared to be major event emblems and words for the protection period of the Rugby World Cup 2011.

Schedule 1 of the Order states:

The major event emblems are as depicted below, or as depicted below but in a different colour or, where the emblems depicted include words or letters, without any of those words or letters.

New tournament primary mark



Old tournament event mark



New tournament primary mark



Old tournament event mark



New tournament event mark



The Webb Ellis Cup device



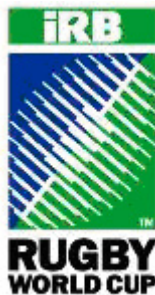
New tournament event mark



The Webb Ellis Cup image - front



Old tournament primary mark



The Webb Ellis Cup image - back



Old tournament primary mark



The Webb Ellis Cup outline with ball



Old tournament primary mark



Part 1 of Schedule 2 of the Order declares the following words and combinations of words to be protected:

International Rugby Board
International Rugby Football Board
IRB
IRFB
RNZ 2011
RNZ 2011 Ltd
Rugby Football World Cup
Rugby New Zealand 2011
Rugby New Zealand 2011 Limited
Rugby NZ 2011
Rugby NZ 2011 Limited
Rugby NZ 2011 Ltd
Rugby World Cup
Rugby World Cup Event
Rugby World Cup Event Mark
Rugby World Cup Host Union
Rugby World Cup Limited
Rugby World Cup New Zealand Rugby Union
Rugby World Cup Observer Programme
Rugby World Cup Official Broadcaster
Rugby World Cup Official Hospitality Agent
Rugby World Cup Official Hospitality Partner
Rugby World Cup Official Licensed Product
Rugby World Cup Official Licensee
Rugby World Cup Official Partner
Rugby World Cup Official Retail Agent
Rugby World Cup Official Retail Partner
Rugby World Cup Official Shop
Rugby World Cup Official Store
Rugby World Cup Official Supplier
Rugby World Cup Official Ticketing Agent
Rugby World Cup Official Ticketing Partner
Rugby World Cup Official Travel Agent
Rugby World Cup Official Travel Partner
Rugby World Cup Organising Committee
Rugby World Cup Primary Mark
Rugby World Cup Qualifier
Rugby World Cup Tournament
Rugby World Cup Tournament Sponsor
Rugby World Cup Worldwide Partner
RWC
Spirit of Rugby
The World in Union
Total Rugby
Webb Ellis Cup
Webb Ellis Cup Collection
Webb Ellis Rugby World Cup

Webb Ellis Rugby World Trophy Cup
Webb Ellis Trophy
Webb Ellis Trophy Cup
World Cup 2011

Part 1 of Schedule 2 of the Order states:

Words if combined with other words

Any words in column A if used in combination with any words in column B

Column A

Column B

IRB Rugby Football World Cup	2011
IRB Rugby World Cup	Broadcaster 2011
IRB Rugby World Cup Event	Champions 2011
IRB Rugby World Cup Tournament	Championship 2011
IRB World Cup	Hospitality Agent 2011
RNZ	Hospitality Partner 2011
Rugby Football World Cup	Host
Rugby New Zealand	Host 2011
Rugby NZ	Host Nation
Rugby World Cup	Host Union
Rugby World Cup Event	Licensed Product 2011
Rugby World Cup Tournament	Licensee 2011
RWC	Observer Programme 2011
Webb Ellis Cup	Partner 2011
World Cup Broadcaster	Qualifier 2011
World Cup Champions	Retail Agent 2011
World Cup Championship	Retail Partner 2011
World Cup Hospitality Agent	Rugby Est. 1823
World Cup Hospitality Partner	Sponsor 2011
World Cup Licensed Product	Supplier 2011
World Cup Licensee	Ticketing Agent 2011
World Cup Observer Programme	Ticketing Partner 2011
World Cup Partner	Travel Agent 2011
World Cup Qualifier	Travel Partner
World Cup Retail Agent	Trophy 2011
World Cup Retail Partner	Two Thousand and Eleven
World Cup Shop	Twenty Eleven
World Cup Sponsor	Worldwide Partner 2011
World Cup Store	
World Cup Supplier	
World Cup Ticketing Agent	
World Cup Ticketing Partner	
World Cup Travel Agent	
World Cup Travel Partner	
World Cup Trophy	

3.1.9.2 Permanently protected emblems and words

Part 3 of the Major Events Management Act 2007 sets out specific emblems and words that are permanently protected.

3.1.9.2.1 Olympic Games and Commonwealth Games

Section 34 of the Major Events Management Act 2007 provides that the Commissioner of Trade Marks must not register an emblem if the use of that emblem by that person would be an offence against section 28.

Section 28(c) of the Major Events Management Act 2007 provides that, unless the New Zealand Olympic Committee Incorporated provides written authorisation, it is an offence to in any business, trade, or occupation display, exhibit, or otherwise use any word, name, title, style, or designation that:

- (i) includes any emblem or word in Parts 1 to 3 of the Schedule; or
- (ii) so closely resembles any emblem or word in Parts 1 to 3 of the Schedule as to be likely to deceive or confuse any person.

Where the following circumstances apply, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to section 34 of the Major Events Management Act 2007:

- The mark consists of or includes an emblem and/or word that has been set out in Schedules 1 to 3 of the Major Events Management Act, or any abbreviation, extension, derivation of the aforementioned, or a name that has the same or similar meaning to the aforementioned.
- Use of the mark has not been expressly authorised by the New Zealand Olympic Committee Incorporated (which must make a decision within 10 working days of application for authorisation or will be deemed to have given the authorisation sought²)
- Use of the mark is not covered by one of the relevant exceptions in section 30 of the Major Events Management Act 2007 namely:
 - That use of the emblem or word is expressly authorised by or under any Act or by the Governor-General by Order in Council; or
 - That immediately before 19 December 1998 use of the emblem or word was:
 1. expressly authorised by a person lawfully entitled to give authority; or
 2. the emblem or word was registered under any statutory authority; or
 - The emblem or word is part of the description of any sporting or recreational facilities operated by a local authority or community organisation; or
 - The emblem or word is to be used for the purposes of or associated with, a radio or television programme, an Internet website, or a film, book, or article for publication in a newspaper or magazine, relating to a person who was a member or official of the New Zealand team that competed at an Olympic Games or Commonwealth Games; or
 - The word comprises the whole or part of the proper name of any town or road or other place in New Zealand; or
 - The word is the surname or initials of a foundation member of the body or of the person engaging in the business, trade or occupation.

The examiner should also consider whether use of the mark would be likely to deceive or cause confusion. For example, if use of the mark may imply sponsorship, permission or approval by New Zealand Olympic Committee Incorporated an objection may be relevant under section 17(1)(a) of the Act.³

The contents of the Schedule to the Major Events Management Act are set out below.

Part 1: Emblems



The Five Ring Olympic Symbol
(as depicted above, or in black)



The Five Ring Olympic Symbol with a Fern Leaf
(as depicted above, or in black, with or without the words "New Zealand" or "New Zealand Olympic Committee" or any abbreviation or combination of those words)



The Five Ring Olympic Symbol with a Fern Leaf and the words "New Zealand"



"Goldie" the Official New Zealand Olympic mascot
(as depicted above, or in any other form, colours, or pose, with or without any sporting equipment, with or without the New Zealand flag or any flag picturing the five Olympic rings, and with or without words or other symbols)



The New Zealand Commonwealth Games Symbol
(as depicted above, or in black)



The Olympic Flame Symbol
(as depicted above, or in any other form, colours, context, or position, or in a hand-held torch with the Five Ring Olympic symbol, whether or not the Five Ring Olympic symbol is on a flag, and whether or not the torch and symbol are with the New Zealand Flag, or a Fern Leaf, or both)



The New Zealand Commonwealth Youth Games Emblem
(as depicted above, or in black)



The New Zealand Youth Olympic Festival Emblem
(as depicted above, or in black)



The Commonwealth Games Federation Emblem

Part 2: Words that are names

1. "Commonwealth Games"; "Five Ring Olympic Symbol"; "Five Ring Olympic Symbol With A Fern Leaf"; "International Olympic Committee"; "New Zealand Commonwealth Games Team"; "New Zealand Commonwealth Youth Games Team"; "National Olympic Committee"; "New Zealand Olympic And Commonwealth Games Association Incorporated"; "New Zealand Olympic Committee Incorporated"; "New Zealand Olympic Team"; "New Zealand Youth Olympic Festival Team"; "Olympic Games"; "Olympic Gold"
1. Any abbreviation, extension, or derivation of the names in clause 1.
2. Names that have the same meaning as, or a similar meaning to, the names in clause 1.

Part 3: Words relating to Olympic and Commonwealth Games

1. The expressions "Turin 2006", "Torino 2006", "Melbourne 2006", "Beijing 2008", and any words in column A when used in connection with any words in column B.

Column A

Commonwealth

Games

Olympiad

Olympian

Olympic

Column B

Turin, Tornio

Melbourne

Beijing

2006, 2008

20th, Twentieth, XXth

26th, Twenty-sixth, XXVIth

29th, Twenty-ninth, XXIXth

1. The expressions "Games City", "Gold Games", "One Team One Spirit", and "One Team Our Team".
2. Any abbreviation, extension, or derivation of a word or words in clause 1 or 2
3. Words that have the same meaning as, or a similar meaning to, a word or words in clause 1 or 2.

Footnotes

¹ See 'Suggestion of Endorsement of License' under 'Deception or Confusion', above for more information.

² See Section 29 of the Major Events Management Act 2007.

³ See 'Suggestion of Endorsement of License' under 'Deception or Confusion', above for more information.